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In re Application of
HOHNEKER, et al.
Serial No.: 10/501,207
PCT No.: PCT/EP03/00232
Int. Filing Date: 13 January 2003
Priority Date: 14 January 2002
Atty Docket No.: ON/4-32312A
For: COMBINATIONS COMPRISING
EPOTHILONES AND
ANTI-METABOLITES

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the applicant's "Inventor's Refusal to Sign: Statement of Facts" filed 02 March 2005 in the United States Patent and Trademark Office (USPTO). The paper is being treated as a petition under 37 CFR 1.47(a) to proceed without the signature of joint inventor John David Rothermel. The \$200.00 petition fee will be charged to Deposit Account No.: 19-0134 as authorized.

BACKGROUND

On 13 January 2003, applicant filed international application PCT/EP03/00232 which claimed priority to an earlier application filed 14 January 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 14 July 2004.

On 09 July 2004, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 09 February 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response.

On 02 March 2005, applicant filed the present petition accompanied by a combined declaration and power of attorney executed by joint inventors John Arthur Hohneker and Paul M.J. McSheehy.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite petition fee required by 37 CFR 1.17(g); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicant has satisfied items (1), (3) and (4) above.

As to item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature....Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted."

Applicant states that a complete set of application papers was mailed to Mr. Rothermel via Federal Express on 13 August 2004. However, applicant has not provided any evidence that the parcel was delivered to Mr. Rothermel nor a firsthand account of the preparation and mailing of the package. Similarly, applicant has not provided a statement from an individual to whom the refusal to sign any further documents was addressed.

In light of the above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice**.

As authorized, the \$200.00 petition fee will be charged to Deposit Account No.: 19-0134.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'Derek A. Putonen'.

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